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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/630,563 | 08/02/2000 | Keiichi Nakajima | PM 271791 NI-0006PCTUS | 9970 |

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| EXAMINER |
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POND, ROBERT M

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,563

Applicant(s)

NAKAJIMA, KEIICHI

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. If applicant desires priority under 35 U.S.C. 119(e)/120/365(c) based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be

submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Information Disclosure Statement

2. The information disclosure statement filed 28 June 2002 Paper #6 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because

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documents are missing and English translations of relevant portions to the instant application are not provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. **Claims 1-11, 15, 17-18, and 20-29 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (a collection of articles cited in PTO-892, Item: U-V), in view of Official Notice regarding old and well-known market research practices and Dunlap (PTO-892, Item: W), further in view of PR Newswire (PTO-892, Item: X) and Gifford (patent number 5,724,424).**

Mobile Commerce teaches the Wireless Application Protocol (WAP) initiative to converge Internet content and wireless standards to support mobile commerce, specifying how Internet content and advanced telephony services can be accessed on digital cellular phones, pagers, and other wireless devices. Mobile Commerce teaches mobile commerce as the delivery of electronic commerce capabilities direct to the consumer's mobile phone- turning the cellular phone into an electronic purse handling cash, loyalty points, tickets, and identification, thereby transforming phones into virtual retail outlets in the pockets of customers. Mobile Commerce teaches a Cellnet service allowing mobile customers, who have Barclaycard credit cards, to obtain statement and other information on the phone's screen (Item: U, pages 1-2). Mobile Commerce further teaches:

- Global Mobile Commerce Industry Forum as a not-for-profit industry body investigating integrating payment systems with mobile telecommunications (Item: U, pages 1-2; Item: V, page 2),

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- Brokat's X-SMS Banking services providing security features to allow users to authorize transactions by typing instructions on the phone's keypad (Item: U, page 2),
- users accessing records and banking processes via electronic signatures (Item: U, page 2),
- SIM2 cards storing basic subscriber data and support for transaction processing carried out by accessing a screen-based menu for filling out transfer details or requesting information (Item: U, page 2),
- integration of phones and smart cards or electronic purses (Item: V, page 2),
- using a personal identification number (PIN) as confirmation, authorizing secure payments or transfers to other accounts, pay bills, or check balances (Item: U, page 2),
- multifunctional mobile products –Nokia Communicator, and the Alcatel One Touch Com combining GSM phone, personal organizer, and Internet e-mail client (Item: U, page 2),

Mobile Commerce teaches all the above as noted under the 103(a) rejection and teaches the Global Mobile Commerce Industry Forum investigating integrating payment systems with mobile telecommunications, but does not disclose specifics on payment systems being investigated. This examiner takes the position that one of ordinary skill in the art investigating payment systems for

mobile commerce would employ old and well-known market research practices by at least investigating dominant players (shakers and movers) in the field of Internet commerce payment systems to ascertain company name and capabilities. Dunlap teaches e-commerce powerhouses Open Market, Inc. and VeriFone announcing an alliance to integrate their technologies. Dunlap teaches Open Market controlling 36 percent of the Internet commerce application software market and VeriFone having more than 50% market share in the gateway or back-end systems that sit in banks via its electronic commerce payment systems (Item: W, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to investigate the Internet commerce and payment systems capability of electronic commerce market powerhouses as taught by Official Notice and Dunlap, in order to better assess the impact of potential Internet commerce and payment systems capability for mobile commerce users.

Mobile Commerce, Official Notice, and Dunlap teach all the above as noted under the 103(a) rejection and further teach a) mobile commerce users on cellular phones conducting electronic commerce, paying bills, authorizing secure payments or transfers to other accounts, and b) investigating the strengths of two dominant players, Open Market and VeriFone, but do not disclose specifics on Open Markets' Internet commerce applications. PR Newswire teaches Open Market receiving US patents. US Patent 5,724,424 (hereafter referred to as Gifford) covers secure, real-time payment using credit and debit cards over the

Internet. PR Newswire further teaches Transact 4 as a core technology in Gifford (Item: X, pages 1-2). Gifford teaches a system and method for purchasing goods or information over a network, the network payment system comprising purchase request, billing, payment authorization, and settlement, and use of smart cards by the payer to effect purchase and payment transactions. Gifford further teaches a) digital advertisements from merchants conveying price and product descriptions, b) purchase requests, c) a payment order comprising a sender, a beneficiary, a payment amount, and transaction identifiers, and d) authentication based on electronic delivery address or network address (see at least abstract; Fig. 1 (68); Fig. 12 (52-60); Fig. 14 (79-92); Fig. 15 (93-94); Fig. 16 (95-102); col. 1, line 5 through col. 3, line 59; col. 7, line 39 through col. 12, line 6). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile Commerce, Official Notice, and Dunlap to include Internet commerce and payment systems as taught by PR Newswire and Gifford, in order to provide mobile commerce customers with comparable online services available to hard-wired users.

Mobile Commerce, Official Notice, and Dunlap teach all the above as noted under the 103(a) rejection but do not disclose transaction identifiers. PR Newswire and Gifford teach all the above as noted under the 103(a) rejection and further teach a) a billing identifier for the purchase transaction, b) a unique transaction identifier used only once, and c) the payment system generating a transaction identifier comprising a random password attached to a network

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address, sending the identifier to the customer, and the customer returning the identifier to the payment system with the payment order for processing (see at least abstract; Fig. 4 (13, 14, 17); col. 2, line 54-58; col. 5, lines 29-44; col. 11, lines 8-21). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile Commerce, Official Notice, and Dunlap to include transaction identifiers as taught by PR Newswire and Gifford, in order to distinguish one transaction from another, and thereby be able to at least track and bill a customer for a given purchase transaction.

5. **Claims 12-14 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (a collection of articles cited in PTO-892, Item: U-V), Official Notice regarding old and well-known market research practices and Dunlap (PTO-892, Item: W), PR Newswire (PTO-892, Item: X) and Gifford (patent number 5,724,424), as applied to Claim 7, further in view of PR Newswire (PTO-892, Item: UU) hereafter referred to as "PRN," further in view of Steinberg (PTO-892, Item: VV).**

Mobile Commerce, Official Notice, Dunlap, PR Newswire, and Gifford teach all the above as noted under the 103(a) rejection and further teach a) integrating smart cards for mobile commerce that serve multifunctional purposes- library card, loyalty programs, electronic purse, debit card, transport ticketing, and ID card (see Item: V, pages 1-2), b) using a smart card to sign a digest of the

payment order (Gifford: see at least col. 10, lines 54 –62), and Transact 4 as core technology in Gifford (Item: X, pages 1-2), but do not disclose specifics on responding to purchase history requests. PR Newswire teaches Open Market's Transact 4 supporting smart cards and payment processes as they arise, and improving Transact 4 to allow sellers access to the purchase history of a given buyer (Item: UU, see at least page 3). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile Commerce, Official Notice, Dunlap, PR Newswire, and Gifford to include purchase history access as taught by PRN, in order to provide better personalized customer service, and thereby attract more mobile customers to the online service. Mobile Commerce, Official Notice, Dunlap, PR Newswire, Gifford, and PRN teach all the above as noted under the 103(a) rejection but do not specifically disclose customer smart cards storing purchase history. Steinberg teaches smart card usage and teaches a smart card storing the complete customer purchase history (Item: VV, page 3). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile Commerce, Official Notice, Dunlap, PR Newswire, Gifford, and PRN to store customer purchasing history as taught by Steinberg, in order for mobile users to conduct electronic commerce with sellers demanding purchase history information.

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6. Claims 16 and 19 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (a collection of articles cited in PTO-892, Item: U-V), Official Notice regarding old and well-known market research practices and Dunlap (PTO-892, Item: W), PR Newswire (PTO-892, Item: X) and Gifford (patent number 5,724,424), as applied to Claim 5 and 17, further in view of Meyers (PTO-892, Item: WW).

Mobile Commerce, Official Notice, Dunlap, PR Newswire, and Gifford teach all the above as noted under the 103(a) rejection and teach a protocol for wireless applications as merging Internet content and advanced telephony services (Item: U, page 2), use of smart cards to prevent fraud, and authentication methods to identify the customer, but do not disclose voice prints for identification. Meyers teaches GTE Telecommunication Services introducing speaker identification technology available to wireless carriers that identifies wireless roamers by using a voice print rather than a numeric code. Meyers further teaches the system being well-suited for wireless applications for evaluating the authenticity of users based on a prerecorded password, voice print, and other biometric characteristics (Item: WW, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile Commerce, Official Notice, Dunlap, PR Newswire, and Gifford to include user voice authentication as taught by Meyers, in order to enhance security and convenience to the customer, and thereby attract more customers to the service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

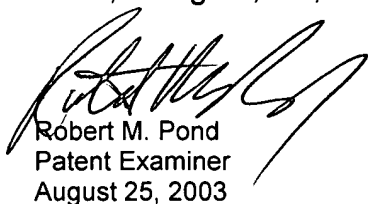
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


Robert M. Pond
Patent Examiner
August 25, 2003